

Patent No. : 7,328,053  
Filed : November 17, 1998

MASIMO.7CP1C5

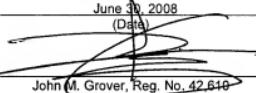
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mohamed K. Diab et al.  
Appl. No. : 09/195,791  
Patent No. : 7,328,058  
Filed : November 17, 1998  
For : SIGNAL PROCESSING  
APPARATUS  
Examiner : Eric F. Winakur  
Group Art Unit : 3768

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June 30, 2008  
(Date)  
  
John M. Grover, Reg. No. 42,610

SUPPLEMENTAL PETITION UNDER 37 C.F.R. §1.181 FOR CORRECTION OF  
PATENT TERM EXTENSION

**Mail Stop Petitions**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R §§ 1.701(a)(1) and 1.701(c)(1)(i) and pursuant to 35 U.S.C. § 154(b), Applicants hereby Petition the Director under 37 C.F.R §1.181 to correct the patent term extension for the present application. (See MPEP § 2720.)

**Patent Term Extension of U.S. Patent No. 7,328,053**

The present application issued on February 5, 2008 as U.S. Patent No. 7,328,053 with an indicated patent term extension under 35 U.S.C. § 154(b) of 0 days. The present application was subject to an interference proceeding under 35 U.S.C. § 135(a) which delayed issuance. Applicants filed a separate §1.181 Petition on April 4, 2008 ("the Earlier Filed Petition") submitting that the patent term extension of the present application should be adjusted by at least 210 days due to the interference proceeding. To date, Applicants have not received a decision on their Earlier Filed Petition.

This §1.181 Petition ("the Present Petition") is intended to supplement the Earlier Filed Petition. Applicants submit that the indicated patent term extension of 0 days is

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incorrect and request that the patent term extension be corrected to reflect: 1) the 210 day delay as set forth in the Earlier Filed Petition; and 2) an additional 246 day delay due to Examiner initiated suspensions due to interference proceedings.

The Patent Term Extension Should Include the 246 Day Delay Due to the Examiner Initiated Suspension of Prosecution Due to Interference Proceedings Under 37 C.F.R. § 1.701(c)(1)(ii)

Applicants submit that the patent term extension should be adjusted by at least an additional 246 days over the Earlier Filed Petition because of Examiner initiated suspensions due to interference proceedings.

37 C.F.R. § 1.701 reads, in part:

(a)A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1)Interference proceedings under 35 U.S.C. 135(a);

(c)(1)The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) ...

Prosecution of this application was suspended twice by the Examiner due to a potential interference. The first suspension was for a period of six months and began on October 3, 2003. The second suspension was for a period of three months and began on May 16, 2006. As evidence of the suspensions, Applicants provide **Exhibit A** and **Exhibit B**, which are copies of the examiner initiated first and second Letters of Suspension, respectively, and which can be found on the "Image File Wrapper" tab associated with the present application on PAIR labeled as entries "Miscellaneous Action with SSP", dated October 3, 2003, and "Letter of Suspension – Examiner Initiated", dated May 16, 2006, respectively. Because the application was "suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a)," Applicants submit that the patent term extension should be adjusted to reflect the appropriate delay.

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Applicants submit that the entire 183 day delay due to the first suspension should be added to the patent term extension. The second suspension overlapped with the amount of delay due to the eventual interference involving the present application and Applicant submits that, under 37 C.F.R. § 1.701(c), the non-overlapping period of 63 days should also be added to the patent term extension. As such, Applicants submit that the requested additional 246 days reflects the cumulative total of the first suspension and the non-overlapping portion of the second suspension, and should be added to the patent term extension.

### Summary

As set forth in the Earlier Filed Petition, Applicants submit that the present application was delayed by at least 210 days due to an interference proceeding in which the application was involved. Moreover, the present application was delayed by 246 days due to suspension of prosecution of the application due to interference proceedings. As such, the Applicants submit that the patent term extension should reflect the cumulative total of at least 456 days of delay due to interference proceedings pursuant to 37 C.F.R. § 1.701, and request that the patent term extension be corrected to reflect at least this amount.

No fee is deemed due under 37 C.F.R. § 1.181 as neither 37 C.F.R. § 1.181 nor 37 C.F.R. § 1.701 indicate that a fee is due in conjunction with a Petition under 37 C.F.R. § 1.181. However, in the event that a fee is due, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 30, 2008

By:

  
John M. Grover

Registration No. 42,610  
Attorney of Record  
Customer No. 20,995  
(949) 760-0404

# **EXHIBIT A**



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/195,791	11/17/1998	MOHAMED K. DIAB	MASIMO.7CPIC	4687
7590	10/03/2003		EXAMINER	
KNOBBE MARTENS OLSON & BEAR 620 NEWPORT CENTER DRIVE SIXTEENTH FLOOR NEWPORT BEACH, CA 92660			WINAKUR, ERIC FRANK	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

08

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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09/195791

EXAMINER

Winakur

ART UNIT	PAPER
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3736 7

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

All claims are allowable. The prior art teaches methods and apparatus for measuring saturation of a blood constituent in a patient including irradiating a patient with two wavelengths and detecting light that has passed through the patient, wherein the detected light includes a motion component. However, the prior art does not teach or suggest an apparatus or method for determining the saturation by generating a plurality of data packets from detected optical measurement signals at two wavelengths, and using a mathematical relationship relating first and second portions of the measured signals at both wavelengths and a ratio of the first portion of the signals at both wavelengths to generate at least first and second functions from the data packets, wherein the first and second functions have a final solution value indicative of the ratio.

However, due to a potential interference, ex parte prosecution is SUSPENDED FOR A PERIOD OF 6 MONTHS from the date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Attachments: Information Disclosure Statements (PTO-1449) -- Papers 2, 4

Eric F. Winakur  
Primary Examiner  
Art Unit: 3736

# **EXHIBIT B**



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/195,791	11/17/1998	MOHAMED K. DIAB	MASIMO.7CPIC	4687
20995	7590	05/16/2006		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER WINAKUR, ERIC FRANK	
			ART UNIT 3768	PAPER NUMBER

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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200605111

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

All claims are allowable. However, due to a potential interference, ex parte prosecution is SUSPENDED FOR A PERIOD OF 3 MONTHS from the date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Attachment: Copies of 1449 from IDS filed 3/20/06 and 3/22/06

  
Eric F Winakur  
Primary Examiner  
Art Unit: 3768

EFW  
5-18-06